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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,600	07/30/2002	Chien Hsing	ACSP0008USA	5132

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NORTH AMERICA INTERNATIONAL PATENT OFFICE (NAIPC)
P.O. BOX 506
MERRIFIELD, VA 22116

EXAMINER

AUVE, GLENN ALLEN

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,600

Applicant(s)

HSING, CHIEN

Examiner

Glenn A. Auve

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/29/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

1. Applicant is advised that should claim 4 or 6 be found allowable, claim 11 or 12, respectively, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5,9-11, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Christopher, U.S. Pat. Application Publication No. 2002/0163780 A1.

As per claim 1, Christopher shows a portable computer (130 and docking cradle 120) that is capable of being connected to a computer (114), the portable computer comprising: a processor (inherent in a PDA); a display device electrically connected to the processor for displaying output of the processor (fig.1); a communications module electrically connected to the processor for communicating with the computer, the communications module having a first mode and a second mode (also in fig.1 and inherent in that the PDA can operate alone or

docked to the PC); and an expansion slot electrically connected to the processor capable of accepting an expansion card for expanding capabilities of the processor (slot into which the card 144 is inserted, or alternatively slots 140); wherein when the communications module is in the first mode the communications module allows communication between the expansion slot and the processor and prevents communication between the expansion slot and the computer, and when the communications module is in the second mode the communications module allows communication between the expansion slot and the computer and prevents communication between the expansion slot and the processor (fig. 4 and paragraphs [0003-0004], [0007-0009], and [0025]). Christopher shows all of the elements recited in claim 1.

As for claim 2, the argument for claim 1 applies. Christopher also shows that the communications module further comprises a third mode, wherein the communications module in the third mode prevents communication between the expansion slot and the processor, and prevents communication between the expansion slot and the computer (inherent in that no communication is possible when no card is installed into the slot). Christopher shows all of the elements recited in claim 2.

As for claim 3, the argument for claim 2 applies. Christopher also shows that the communications module is in the third mode when the expansion card is removed from the expansion slot (see claim 2 above). Christopher shows all of the elements recited in claim 3.

As for claims 4 and 11, the argument for claim 1 applies. Christopher also shows a connection port electrically connected to the communications module, wherein the connection port is capable of being connected to the computer (either the port coupling the PDA to the cradle or the port coupling the cradle to the computer). Christopher shows all of the elements recited in claim 4.

As for claim 5, the argument for claim 4 applies. Christopher also shows that the mode of the communications module is set by the communications module detecting a state of the connection port of the portable computer, wherein the communications module is in the first mode when the connection port is not connected to the computer, and the communications module is in the second mode when the connection port is connected to the computer (paragraphs [0016] and [0025]). Christopher shows all of the elements recited in claim 5.

As for claim 9, the argument for claim 1 applies. Christopher also shows that the mode of the communications module is set by the processor and the computer (paragraphs [0016] and [0025]). Christopher shows all of the elements recited in claim 9.

As for claim 10, the argument for claim 9 applies. Christopher also shows that the communications module further comprises a fourth mode, wherein the communications module allows the expansion slot to communicate with both the processor and the computer (paragraph [0025]). Christopher shows all of the elements recited in claim 10.

As for claim 13, the argument for claim 1 applies. Christopher also shows an input device for interfacing with the portable computer (paragraph [0026]). Christopher shows all of the elements recited in claim 13.

As for claim 14, the argument for claim 1 applies. Christopher also shows that the expansion card is a secure digital (SD) card (paragraphs [0003-0004] and [0025]). Christopher shows all of the elements recited in claim 14.

As for claim 15, the argument for claim 1 applies. Christopher also shows that the expansion card is a flash memory card (paragraphs [0003-0004] and [0025]). Christopher shows all of the elements recited in claim 15.

As for claim 16, the argument for claim 1 applies. Christopher also shows that the display device is a liquid crystal display (LCD) (inherent in PDA 130). Christopher shows all of the elements recited in claim 16.

4. Claims 1-5,9-11, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Palatov et al, U.S. Pat. Application Publication No. 2003/0063196 A1.

As per claim 1, Palatov shows a portable computer (100) that is capable of being connected to a computer (figs.1D or 3D, 130), the portable computer comprising: a processor (202); a display device electrically connected to the processor for displaying output of the processor (104); a communications module electrically connected to the processor for communicating with the computer, the communications module having a first mode and a second mode (208); and an expansion slot electrically connected to the processor capable of accepting an expansion card for expanding capabilities of the processor (118); wherein when the communications module is in the first mode the communications module allows communication between the expansion slot and the processor and prevents communication between the expansion slot and the computer, and when the communications module is in the second mode the communications module allows communication between the expansion slot and the computer and prevents communication between the expansion slot and the processor (paragraph [0055], wherein the data storage card can be directly accessed by the PC when the portable computer is coupled to the PC, and when they are not coupled the processor accesses the card). Palatov shows all of the elements recited in claim 1.

As for claim 2, the argument for claim 1 applies. Palatov also shows that the communications module further comprises a third mode, wherein the communications module in the third mode prevents communication between the expansion slot and the processor, and

prevents communication between the expansion slot and the computer (inherent in that no communication is possible when no card is installed into the slot). Palatov shows all of the elements recited in claim 2.

As for claim 3, the argument for claim 2 applies. Palatov also shows that the communications module is in the third mode when the expansion card is removed from the expansion slot (see claim 2 above). Palatov shows all of the elements recited in claim 3.

As for claims 4 and 11, the argument for claim 1 applies. Palatov also shows a connection port electrically connected to the communications module, wherein the connection port is capable of being connected to the computer (112). Palatov shows all of the elements recited in claim 4.

As for claim 5, the argument for claim 4 applies. Palatov also shows that the mode of the communications module is set by the communications module detecting a state of the connection port of the portable computer, wherein the communications module is in the first mode when the connection port is not connected to the computer, and the communications module is in the second mode when the connection port is connected to the computer (paragraph [0055]). Palatov shows all of the elements recited in claim 5.

As for claim 9, the argument for claim 1 applies. Palatov also shows that the mode of the communications module is set by the processor and the computer (paragraph [0055]). Palatov shows all of the elements recited in claim 9.

As for claim 10, the argument for claim 9 applies. Palatov also shows that the communications module further comprises a fourth mode, wherein the communications module allows the expansion slot to communicate with both the processor and the computer (paragraph [0055]). Palatov shows all of the elements recited in claim 10.

As for claim 13, the argument for claim 1 applies. Palatov also shows an input device for interfacing with the portable computer (106). Palatov shows all of the elements recited in claim 13.

As for claim 14, the argument for claim 1 applies. Palatov also shows that the expansion card is a secure digital (SD) card (paragraph [0004] and wherein the SD card is a type of compact flash card often used in digital cameras and Palatov's invention deals mainly with being able to read data from digital camera cards). Palatov shows all of the elements recited in claim 14.

As for claim 15, the argument for claim 1 applies. Palatov also shows that the expansion card is a flash memory card (paragraph [0004]). Palatov shows all of the elements recited in claim 15.

As for claim 16, the argument for claim 1 applies. Palatov also shows that the display device is a liquid crystal display (LCD) (104). Palatov shows all of the elements recited in claim 16.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christopher or Palatov as applied above in view of Wilson et al., U.S. Pat. Application Publication No. 2004/0072540 A1.

As for claims 6 and 12, the argument above for either Christopher or Palatov applies. Neither Christopher nor Palatov shows a wireless communications module electrically connected to the communications module, wherein the wireless communications module is capable of exchanging signals with the computer. However, Wilson shows using a wireless communication module for sending data from a PDA to a computer or remote network in order to send and receive large quantities of data across a link (at least in the abstract and paragraph [0007]). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a wireless communication module as shown by Wilson in the system of either Christopher or Palatov in order to send and receive large quantities of data without having to use a physical link.

As for claims 7 and 8, the argument for claim 6 applies. As above for claim 5, Christopher and Palatov show the mode of communication being set depending on connection status between the portable computer and the computer. Similarly, the combination of Christopher or Palatov with Wilson would have the mode set depending on whether or not the wireless communication module is communicating with the computer.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references show other portable computers docking with another computer.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn A. Auve whose telephone number is (571) 272-3623. The examiner can normally be reached on M-F 8:00 AM-5:30 PM, every other Friday off.

Art Unit: 2111

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (571) 272-3632. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Glenn A. Auve
Primary Examiner
Art Unit 2111

gaa
18 February 2005